

REMARKS

Applicant requests further examination and reconsideration of the present application.

Applicant has amended Claim 1 to include the limitations that said lifter body is ferrous material selected from the group consisting of cast iron, steel, and stainless steel and wherein said lifter body is not heat-treated; the face pad is selected from the group consisting of metal carbide, tungsten carbide, titanium carbide, niobium carbide, tungsten carbide, tantalum carbide, and niobium carbide; and the connector material comprises three layers, which are first and second layers comprising silver, and a third layer comprising copper between said first and second layers. All the amendments are supported in the original specification and claims, so no new matter has been added. Support for the limitation of no heat treating is at page 6, lines 29 and 30 of the original application, so no new matter has been added.

Applicant contends that nowhere in the prior art is this combination shown or suggested, and it is not obvious to arrive at the claimed combination. While individual of the cited references may mention individual of the claimed elements, nowhere is there found the claimed combination and the references do not teach the combination. Lifting an element out of each of the cited references to try to arrive at the claimed invention would be lifting elements out of a “shopping list” of elements and would not make the claimed invention obvious.

The fact that all or most of the elements of a combination may be found in various patents does not of itself negate an invention. “[E]lements of separate prior art patents cannot be combined when there is no suggestion of such combination anywhere in those patents[.]” “Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents[.]” Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987).

Certainly, trying to combine single elements lifted out of five different references, *Lesher, Taniguchi, et al, Tsuno, Behnke, and Goloff*, is a “shopping list” approach, as discussed above, and does not make the claimed invention obvious. Therefore, Applicant contends that there is no *prima facie* case of obviousness in the present case.

Also, even if a combination were made, which Applicant contends is not reasonable, the combination would not arrive at the invention as claimed in amended Claim 1, nor in dependent Claims 5, 17, 21, 23, and 24, which dependent claims add additional limitations to the base claim(s). Especially, the cited references do not teach or suggest a lifter body of ferrous material that is not heat-treated; the references are silent about heat-treating or they teach heat-treating (see Goloff, column 3, lines 7 – 20). Applicant's claimed combination makes conventional heat-treatment of ferrous lifter bodies unnecessary and not particularly beneficial, so that the steps and complexity of preparing the lifter body are reduced. Support is at page 6, lines 29 and 30 of the original application, so no new matter has been added. Also, the references to not teach Applicant's particular connection material as claimed in Claims 5, 23, 24, and do not teach Applicant's combination with the specific dimensions of Claims 17 and 21. Therefore, Applicant contends that independent Claim 1 and its dependent Claims are novel and unobvious.

Claims 2-4, 6 – 16, 18 – 20, and 22 are canceled, and Claims 25 – 28 are withdrawn as unelected, to move the case to allowance.

Applicant now believes the application is in condition for allowance and respectfully requests the same.

Respectfully submitted,



Barbara S. Pedersen Date: Feb 10, 2006

Ken J. Pedersen, Registration No. 29,689
Barbara S. Pedersen, Registration No. 36,237
P.O. Box 2666
Boise, ID 83701-2666
Telephone: 208-343-6355
Facsimile: 208-343-6341